No. 47.

Brief of Abney for

Filed Oct. 27, 1899.

Clerk Supreme Court U. S.
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JAMES H. McKENNEY,
Clerk.

Supreme Court of the United States,

OCTOBER TERM, 1897.

CHARLES E. BOLLES,
Plaintiff in Error,

v.

THE OUTING COMPANY, LIMITED,
Defendant in Error.

47

BRIEF SUBMITTED BY JOHN R. ABNEY, COUNSEL FOR DEFENDANT IN ERROR.

Statement.

The plaintiff in error sought at the trial to establish the proposition that by showing by the company's printer how many copies he printed for it, and by the American News Company how many copies it sold for defendant, the plaintiff in error could submit it to the jury to infer how many copies had been in the possession of defendant and the finding of the jury would be what is meant by "found in his possession" in the statute. This is the main point raised by plaintiff in error.

POINTS.

FIRST.

The Courts below properly construed the words of the statute, "found in his possession."

I.

In the case of Reed *v.* Carusi, from which the counsel for plaintiff in error quotes, I find no statement of the facts proved. It may have been that the plaintiff in that case actually found in the possession of that defendant the number of sheets alleged. The words of the act, "found in his possession," do not seem to have been the subject of construction in that case. The remarks of Chief Justice Taney, quoted by my opponents, seem to have been used in regard to the Statute of *Limitations*. It is therefore no authority for the admission of the evidence of the witness Ridge, which the Court rejected (Transcript, p. 22) and which forms the basis of alleged error No. 1 (p. 27).

But even if that case were in point, it would not be good authority now. It was a Circuit Court decision by Chief Justice Taney in 1845. Four years after that (in 1849), the meaning of the words "found in his possession" was fully discussed before the Supreme Court of the United States in the case of Backus *v.* Gould, 7 How., 798, and their meaning *settled*. In that case the defendant's counsel prayed the Court below, among other things, as follows: "9th. In regard to the amount "of the penalty to be recovered, the *defendant's* "*counsel* insisted that the *plaintiffs could only*

"*recover* fifty cents *for every sheet* of the matter "transferred from said index to first, second and "fifth volumes of Cowen's Reports, and second "volume of Wendell's to the said digest "of said defendant, *as had been proved to* "*have been found in his possession*, and "either printing or printed, published, "or exposed for sale, and that there was no legal "proof that any such sheets of said matter had "been so found in said defendant's possession, and "prayed the Court so to instruct the jury. But "the *counsel for plaintiffs* insisted that they "were entitled to recover fifty cents for every "sheet of such matter which *had been published*, "*or procured to be published*, by the defendant, "*whether the same were proved to have been* "*found in the defendant's possession or not*, and "*so the Court decided* and instructed the jury, and "*refused to instruct the jury as prayed by the* "*counsel for the defendant*, to which decision and "instruction, and refusal to instruct, the defend-"ant's counsel excepted" (See 7 How., 802). Upon such charge and instruction the jury found a verdict for the plaintiff in that case for $2,069.75 penalty. The Supreme Court considered the construction of the words "found in his possession" under the foregoing ninth prayer; and as the decision turned upon it, no other questions were considered (*Ib.*, p. 811). The argument of counsel is given on that point alone (*Ib.*, p. 802). I respectfully refer this Court to the full and able argument of Mr. James Bayard in that case, on the very point in question now. The Supreme Court reversed the decision below on the ninth prayer, and it used this language: "This *penalty* of fifty cents on "each sheet, whether printed, or published, or ex-

" posed to sale, *is limited to the sheets in posses-*
" *sion of the defendant.* But, under the instruc-
" tion of the Court, *a verdict* was rendered *for*
" *every sheet* which the *defendant had published*
" *or procured to be published.*"

Thus the question has not been an open one since that decision in 1849.

II.

Counsel for plaintiff in error indulge in some remarks as to the act being remedial, and then say: " In the light of these facts it is, therefore, obvious " that the ordinary principle of law, that penal " statutes are to be construed strictly, has little, if " any, application to this provision of the present " copyright law." But, in the above cited case of Backus *v.* Gould the Supreme Court said: "*As this is the penal section, it must be strictly construed.*"

In the face of that decision, the cases of Dwight *v.* Appleton, 1 N. Y. Legal Abs., 195; Meyers *v.* Calahan, 5 F. R., 726; Ferrett *v.* Atwell, 1 Blatch., 156; Taft *v.* Stephens Lith. & Eng. As., 38 F. R., 28, cited by my opponents, would not be authority, even if they were in point. But they are not in point at all. Nor is Stockwell *v.* U. S., 13 Wall., 531, which is also cited by my opponents.

III.

The case of Carter *v.* Young, 42 Superior Ct., 172, cited by my opponents, has no application; for it construed a civil statute to facilitate the service of process, not a penal statute, and is not in point any way. Nor are Rapalje's Law Dictionary, the Cen-

tury Dictionary, Sec. 2,333 U. S. Rev. Stats., Ivan Silver Mining Co. *v.* Mike and Horr Gold Mining Co., Tower *v.* Tower, 18 Pickering, 262, and 53 Mo., 208.

IV.

Dwight *v.* Appleton, 1 N. Y., Leg. Abs., 195, cited by plaintiff's counsel, was decided at Circuit in 1843, six years before Backus *v.* Gould.

Millett *v.* Snowdon, 1 West. L. J., 240, cited for plaintiff, is certainly not authority to sustain the contention that Ridge could be asked how many copies he had printed. It is the reverse. Moreover, it was decided at Circuit in 1844, and is not authority in the face of Backus *v.* Gould.

I have already noticed Reed *v.* Carusi.

The construction sought to be placed on Backus *v.* Gould is untenable. The contention in that case, as in this, was, that the jury could find from the number published that so many books had been found in the possession of defendant. But the Court held that the books must have been actually *found* in the possession of the defendant. Counsel for plaintiff, in speaking of the books in that case, say: "None had been in his possession." But the report of the case says the plaintiff "proved a sale by the defendant of *five hundred copies.*" So it is clear that to prove publications or sales amounts to nothing. The proof must be that copies are *found* in the actual possession of defendant. If the defendant has sold the copies before they are found in his possession, no action accrues to plaintiff.

In Thornton *v.* Schreiber, 124 U. S., 620, the Court say: "Counsel for defendant in error, "Schreiber & Sons, insist that the words 'found

" 'in his possession,' are to be construed as refer-
" ring to the finding of the jury ; that the expres-
" sion means simply that where the sheets are as-
" certained by the finding of the jury to have been
" at any time in the possession of the person who
" committed the wrongful act, such person shall
" forfeit one dollar for each sheet so ascertained to
" have been in his possession. We, however, think
" that the word 'found' means that there must be
" a time before the cause of action accrues at which
" they are *found* in the possession of the defend-
" ant." In other words the cause of action does not accrue until the sheets are actually *found* in possession. If they go out of possession before they are *found*, no cause of action can accrue. This is the plain construction of the statute. The word "found" is used in its ordinary acceptation. The plaintiff in error has proceeded upon the theory that he could establish a case for an enormous amount of penalty by showing how many copies were printed and sold. But the jury cannot ascertain it in that way. There must be proof that a number of copies were *found* in the possession of defendant before there can be any cause of action.

3 Law Rep. Qu. B., 395, cited by plaintiff's counsel, has nothing to do with the case, for there the statute gives the penalty for the copies *sold*. Counsel have left out the material part of the quotation and placed asterisks instead. The question in that case was merely whether the penalty was ten pounds for every book or for the whole. The case is totally inapplicable to this case.

V.

Counsel discuss in several places the alleged fu-

tility of the statute if they are held to the rule that a recovery must be based only on the number of copies they have actually found in possession. But they forget that defendants are not allowed to show their innocence of any intention to do wrong, or ignorance of the fact that a cut from which they print has been made from a copyrighted photograph. The very case plaintiff's counsel have cited (Millett *v.* Snowdon, 1 West. L. J., 240) shows that ignorance or innocence is no defense for a defendant.

See also Drone on Copyright, 403.

The position of counsel is:

Their client can give a photograph to be copied, and then claim it was only to be copied in one magazine of a publishing company and not in another of the same company; and if a cut is made of it and the terms of the gift are not strictly construed, and a defendant innocently copy it in all its magazines, he (the plaintiff) can claim $50,000 penalty, however innocent the defendant may be. The plaintiff can, like Shylock, demand his pound of flesh; but he winces when the same rigid requirement is made of him to abide the letter of the law! The law does not give this enormous penalty against both the designing and the innocent offender without placing some limitation on the greed of every little copyright holder. *He must find the copies in possession of the offender.*

Mr. Bayard, in his argument in Backus *v.* Gould, assigns several reasons for the law's giving the penalty only for the copies found in the defendant's possession:

"1st. Congress did not intend that an author "should lie by during the two years allowed for

"bringing his action, permitting another to pub-
"lish and vend his work during that time, and
"then recover * * * for every sheet so pub-
"lished. This would be laying a trap for his ruin,
"as I have shown that the penalty upon an ordi-
"nary edition might exceed $15,000, and, if it
"were a popular work, several such editions might
"be disposed of in the course of two years.

* * * * * *

"3d. Again, it might be that a person who had
"unintentionally violated a copyright by the pub-
"lication of a book, might, upon discovering that
"his publication was illegal, destroy the whole
"edition, and so relieve himself from the penalty.
"But according to the decision of the Circuit Court
"he would still be liable. If the intention of the
"Legislature was what the Circuit Court held it
"to have been, it would have been perfectly easy
"and most obviously proper to have expressed
"that intention, either by omitting the words
"'which may be found in his possession,' or by
"adding after the word 'sale' in the next line,
"the words, 'or which he may have sold or caused
"to be sold.'"

In Sarony *v.* Ehrich, 28 F. R., 80, Judge COXE said: "The section must be strictly construed
"(Backus *v.* Gould, 7 How., 798). No authority
"has been cited to sustain the proposition that
"when the piratical prints are out of the possession
"and beyond the control of the infringer the pro-
"prietor of the copyright can recover of him their
"value in an action at law. It would require an
"exceedingly strained construction, almost a dis-
"tortion of the act, to make it fit the present cir-
"cumstances. It is no answer to say that the
"remedy provided by law is ineffective; that the

" wrongdoer may escape the consequences of his " infringement; that the opportunity for redress " diminishes in proportion to the success of the in- " fringement, and ceases wholly when the wrong " is fully consummated. These arguments might, " with great propriety, be addressed to the law- " making power, and Congress could, perhaps, be " induced to render effectual, by a few simple " amendments, provisions which, in their present " form, are so obviously defective and inadequate. " With these considerations, however, the Courts " have nothing to do. They must deal with the " law as it is, not as it ought to be."

Counsel for plaintiff in error ask: "Must the plaintiff himself see them in the actual possession of the defendant?" I answer that was the probable intention of Congress, as only he and the defendant were contemplated as parties to the matter. If strangers had been contemplated, it would have been easy for the statute to say so. Moreover, strangers are not supposed to know of the copyright, and no duty would devolve on them to notify a person that he was innocently or wilfully infringing upon the rights of the copyright holder. It is certain that the printer does not find the copies in the possession of his employer, within the meaning of the statute; and it is equally clear that the selling agent does not find them in the possession of his principal, within the meaning of the statute. The finding must at least be done by some outside party. The plaintiff so understood the law when he sent his employer to the office of defendant. He only claims to have found *one* copy; and to prove printing by an employee and receipts for sale by an agent, against their protest, is not permissible or competent under

the statute. Such a construction as plaintiff contends for would ruin many an innocent publisher. If it ruined only the wilful pirates it would not matter; but there is no justice in ruining the innocent. The amount sued for in this case shows how wise Congress was to confine recoveries to copies *found in possession*, otherwise there would be no limit to recoveries against the innocent.

The defendant in this case is a publisher of magazines, and is more interested in upholding a just copyright law than the plaintiff. But plaintiff is contending for a construction unjust and contrary to the decisions of the Supreme Court.

SECOND.

The notice imprinted on the photograph did not fill the requirements of the statute.

SECTION 4962, PRESCRIBING THE FORMULA OF NOTICE MUST BE STRICTLY COMPLIED WITH.

In Baker *v.* Taylor, 2 Blatch., 84, the Court says:

"The Supreme Court of the United States, in the "case of Wheaton *vs.* Peters, 8 Pet. 591, has given "an exposition of our statutes, which is obligatory "on this Court, and essentially covers the main "question raised on this motion. The principle de- "clared by this decision is, that under the laws of "the United States *a copyright title is not perfected "without a strict compliance with the provisions of "the statute.* Those requirements which, in Eng- "land, are generally regarded as directory, and not

'as conditions precedent to title * * * are, "under our laws, important and indispensable pre-"requisites to a perfect title. Depositing the title "page in the proper clerk's office, *publishing a "notice according to the act*, and delivering a copy "of the book, are held to be conditions, the per-"formance of which is essential to the title. On "that authority I think the point is placed beyond "question, that the failure, in the present case, to "publish the notice demanded by the act, in the "manner directed, creates a fatal defect in the "plaintiff's title. (The defect in the notice was, "having the notice read: 'Entered according to "the Act of Congress, in the year 1847, by Baker & "Scribner, in the Clerk's office of the District Court "for the Southern District of New York;' whereas "the real date of entry was 1846). Even though "the failure to publish the statutory notice arose "from mistake, this Court would have no power to "accept the intention of the party, in place of a "performance, any more in respect to the insertion "of that notice on the proper page, than in respect "to the deposit of the title of the book.

"The plaintiffs knew of the error before the book "was published. They, however, regarded it as "trivial, and not worth the expense and trouble of "correction. But Congress, in the 5th Section of "the Act of 1831, have seen fit to make the copy-"right dependent upon the particular act giving "the notice; and. to mark its importance, the "statute sets forth the words in which the notice "shall be given. *The direction must be strictly "complied with.*"

In Jackson *v.* Walkie, 29 F. R., 16, the Court say:

"Since the decision of the Supreme Court of the "United States in Wheaton *vs.* Peters, 8 Pet.,

"591, it has been the recognized rule in this class "of cases that a party must bring himself *strictly* "within the terms of the statute in regard to copy- "right in order to protect his property in case of "publication."

Again the Court say:

"Argument seems hardly necessary to show that "the defendant in this case has not complied with "the statute in this regard. He has not given "either of the forms of notice which the statute "specifically requires him to give, in order to be "entitled to bring a suit for the protection of his "alleged copyright. (The notice there given was, "'Entered according to Act of Congress, in the "year 1878, by H. A. Jackson.') If an author or "proprietor of a book or literary work can change "the formula prescribed by the statute for his "notice of copyright to the public by omitting the "words left out of this notice, he may omit other "words, or adopt an entirely different form, or "may change the location of the notice. He may "think that the title page, or the page immediately "following, is not as good a place to print the "notice as some other place in the book, and may, "therefore, insist that he has a right to exercise "his own judgment as to *where he will print his* "*notice*, as well as the form in which it shall be "printed. *An author or proprietor of a work has* "*no right to say, in effect, that any part of the* "*prescribed notice is immaterial and may be* "*omitted.* He takes his copyright under the law "only by giving the notice, and *the entire notice*, "which the statute provides; and the statute "expressly declares that he shall not maintain an "action unless he has complied with this condition.

"Hence, I think the bill fails to show a valid "copyright in complainant."

The plaintiff's notice is defective:

I.—Because he has left out the figures "18" in the notice.

II.—He has not inscribed the notice visibly on the photograph, and he is estopped by such carelessness from a recovery against the plaintiff.

"The omission to cause the date of entry of a map "to be engraved on some visible portion thereof "will prevent a recovery."

King *v.* Force, 2 Cranch, C. C. R., 208.

In Higgins *v.* Keuffel, 24 Blatch., 331, the Court says:

"The exact form of the notice is prescribed by "law, and no equivalent is provided for nor any "room for improvement left. If that specific no- "tice is not given, the right of action otherwise "conferred is withheld. All the requirements of "law on which the right of action rests must be "complied with or the suit cannot be maintained. "* * * This notice ('Registered, 3693, 1883'), "is so defective that the publication of the label "with no other was the same in effect as the pub- "lication without any would have been. Such a "publication is practically an abandonment of the "copyright."

The Courts in this Circuit have thus consistently construed the statute strictly. And while that is so and the statute is perfectly plain—so plain that it actually contains the figures left out—this Court could not follow the case of Merckmeister *v.* Mfg. Co., 63 Fed. R., 445, 452, cited by plaintiff's coun-

sel, were it exactly in point. But even that case has an apostrophe in the place of the figures "18," whereas in our case there is no apostrophe even. Counsel say: "93, in the connection 'Copyright 93, Bolles, Brooklyn,' could mean nothing else than the year 1893." I answer that it could mean "No. 1893" or "1793." But counsel says there was no copyright law in this country in any "93" except "1893." The first copyright law passed by Congress was passed May 31, 1790 (see 1 Statutes at Large, 124).

THIRD.

The copyright claimed by Bolles is not sanctioned by the Constitution.

U. S. Cons., Art. I., § 8, says:

"The Congress shall have power * * * ; *To* "*promote the progress of science and useful arts* by "securing for limited times to *authors and in-*"*ventors* the exclusive right to their respective "*writing and discoveries.*"

Act of Congress, May 31, 1790, is entitled:

"An Act *for the encouragement of learning*, by "securing the copies of maps, charts and books, to "authors and proprietors of such copies, during "the time therein mentioned."

In Burrow-Gile Lith. Co. *v.* Sarony (111 U. S., 56), the Court say:

"Under the acts of Congress designed to give "effect to this section (Section 8 of Article I. of "the Const.), the persons who are to be benefited

" are divided into classes, *authors* and *inventors*.
" The monopoly which is granted to the former is
" called *copyright*; that given to the latter, *letters*
" *patent*, or, in the familiar language of the pres-
" ent day, patent right."
Again, at pages 57-8, the Court say:

" An author in that sense is 'he to whom any-
" thing owes its origin; originator, maker, one
" who completes a work of science or literature.'"
Again the Court say:

" By writings in that clause is meant the literary
" productions of those authors, and Congress very
" properly has declared these to include all forms
" of writing, printing, engraving, etching, etc., by
" which the ideas in the mind of the author are
" given visible expression."
Again the Court say:

" We entertain no doubt that the Constitution is
" broad enough to cover an act authorizing copy-
" right of photographs, *so far as they are repre-*
" *sentations of original intellectual conceptions*
" *of the author*."
Again the Court say;

" But it is said that an engraving, a painting, a
" print, does embody the intellectual conception of
" its author, in which there is novelty, inception,
" originality, and therefore comes within the pur-
" pose of the Constitution in securing its exclusive
" use or sale to its author, while the photograph is
" the mere mechanical reproduction of the physical
" features or outlines of some object animate or
" inanimate, and involves no originality of thought
" or any novelty in the intellectual operation con-
" nected with its visible reproduction in shape of
" a picture. * * * *This may be true in regard*

" *to the ordinary production of a photograph,* " and further, that *in such case a copyright is no* " *protection.* On the question as thus stated we " decide nothing."

Again the Court say:

" In regard, however, to the kindred subject of " patents for invention, they cannot by law be " issued to the inventor until the novelty, the " utility, and the actual discovery or invention by " the claiment have been established by proof be- " fore the Commissioner of Patents; and when he " has secured such a patent, and undertakes to " obtain redress for a violation of his right in a " court of law, *the question of invention, of* " *novelty, of originality, is always open to exam-* " *ination.*"

Again the Court say:

" Our copyright system has no such provision for " previous examination by a proper tribunal as to " the originality of the book, map, or other matter " offered for copyright. * * * It is, therefore, " much more important that when the supposed " author sues for violation of his copyright, *the ex-* " *istence of those facts of originality, of intellec-* " *tual production, of thought, and conception* on " the part of the author *should be proved,* than in " the case of a patent right."

Again the Court say:

" In the case before us we think this has been " done. The third finding of fact says, in re- " gard to the photograph in question, that it is a " 'useful, new, harmonious, characteristic, and " graceful picture, and that *plaintiff made the* " *same * * * entirely from his original men-* " *tal conception, to which he gave visible form by*

"POSING *the said Oscar Wilde in front of the "camera, selecting and arranging the costumes, "draperies, and other various accessories in said "photograph, arranging the* SUBJECT *so as to "present graceful outlines, arranging and dis- "posing the light and shade, suggesting and "evoking the desired expression, and from such "disposition, arrangement, or representation, "made entirely by plaintiff, he produced the "picture in suit.'*

"*These findings, we think, show this photograph "to be an original work of art, the product of "plaintiff's intellectual invention, of which the "plaintiff is the author.*"

In Falk *v.* Donaldson, 57 Fed. R., 33, the Court say:

"The question is whether the *artist was Miss "Marlowe, or complainant.* How far the artistic "contributions are to be attributed to the talent of "Miss Marlowe, it is impossible to say. The tes- "timony of complainant as to his share in pro- "ducing the result is not denied. *He was an "*ARTIST *before he became a photographist.*"

In Clayton *v.* Stone, 2 Payne R., 382, the Court say:

"The object of the act is the *encouragement of "learning*, and was not intended for the encourage- "ment of *mere industry.*"

In Thornton *v.* Schreiber, 124 U. S., 613, the Court say:

"Photographs are included *under certain cir- "cumstances* among the things which may be "copyrighted."

But a photograph must be such as to promote

science, in order to be entitled to protection under the statute.

In Baker *v.* Selden, 101 U. S., 105, the Court say:

"Although great praise may be due to the "plaintiffs for their industry and enterprise in "publishing this paper, yet the law does not con- "template their being rewarded in this way: It "must get its patronage and protection from its "utility to the public, and not as a work of "science."

If any other rule prevailed, those who were most industrious would monopolize the business of photographing inanimate objects. The first comer would photograph a yacht from its various sides; and every other photographer would be a pirate.

It is well known that only from one spot can the best view be gotten of certain objects. It would retard instead of "promote" the progress of science and useful arts to give one person the sole right to take and sell photographs of objects from those views. And yet that is what plaintiff is claiming. He does not claim that he took hold of the yacht and created a position as was done with Oscar Wilde and Miss Marlowe. What he claims, is that he was in the position from which he could get the best view of the yacht and then took the photograph. He does not claim to have reached his hand up to the clouds and drawn them as curtains about, so as to make the lights and shadows about the yacht. He merely claims to have seen them (Tr., p. 13). The other part of making the snapshot and developing the negative, &c., was the ordinary routine of a photographer. And this photograph, as the exhibit shows, is merely an ordinary photograph. Three other photographers there making photographs at the time, and doubtless

many of them looked like that taken by Bolles. It would not be hard for some of them to be better. Doubtless he careered about in his tugboat a good deal, propelled by his "artistic temperament"; but he did not create the poise of the *Vigilant*. He only saw her as other people behind or in front, and perhaps beside him, saw her. He may have been industrious to get to that point of view; but such industry was never intended by the Constitution to give a monopoly of that view. He might, perhaps, under the common law restrain the use of his photograph; but he has no right to have it copyrighted. The copyright is invalid.

FOURTH.

This case is wholly without merit.

Plaintiff put in evidence part of the correspondence, viz., Letters Exhibits 2, 3 and 4, but he did not put in Exhibit 5 (see Tr., pp. 19, 25-26); and now his counsel say in their statement of facts: "The defendant in error had no permission, either printed or verbal, to use the photograph" (see Pltff's. Brief, p. 2). But even what he did put in shows that the defendant was no pirate (Tr., p. 26). And such a demand as the plaintiff's shows only a spirit of marauding. If the statute were construed as he wishes, the innocent publishers, as well as the pirates, would be at the mercy of the holders of small and insignificant copyrights. I know nothing of the important cases in many circuits being held over for this decision. Doubtless, if the rule in Gould *v.* Backus were reversed, there

would be many such cases as this. But I submit that that decision is still the law, as it has been for nearly fifty years, and is but the declaration of the plain terms of the statute.

FIFTH.

I submit that the writ of error should be dismissed with costs to defendant in error.

JOHN R. ABNEY,
Attorney for Defendant in error.

JOHN R. ABNEY,
Of Counsel.